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EXAMINER

ARK, DARREN W

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,673

Applicant(s)

BUCZKOWSKI, ANDRZEJ

Examiner

Darren W. Ark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 8-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species I - Figs. 1-3; Species II - Fig. 4A; Species III - Fig. 4B; Species IV- Fig. 4C; and Species V - Fig. 4D.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, and 8-19 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

2. During a telephone conversation with William R. Moran on Thursday, March 10, 2005 a provisional election was made with traverse to prosecute the invention of Species I, claims 1, 2, 4, and 8-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3 and 5-7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: hooks no. 26 are not shown in Fig. 2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because the plurality of flexible strings or ribbons should be assigned a reference number in Fig. 3. Corrected drawing sheets in

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compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:

Page 4, lines 18-19, the phrase "a the from end of sleeve 12" is unclear.

Page 5, line 7, the term "I" should be changed to --It--.

Page 6, lines 3-4, the phrase "as well as hook xx be capable of..." is unclear.

Appropriate correction is required.

Claim Objections

6. Claims 1, 2, 4, 8-20 are objected to because of the following informalities:

Claim 1, line 5, second occurrence of the term "of" should be deleted.

Claim 15, line 1, the second occurrence of "wherein" should be deleted.

Claim 20, line 4, the term "shape" should be changed to --shaped--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 8-15, 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regard to claims 8 and 20, it is unclear from the specification and figures exactly how the item 22 and the item 24 swivel at opposite ends of the holder 16.

In regard to claim 11, the specification does not particularly disclose the material in which the arms are made of as being from the group consisting of flexible metal wire, plastic wire, and fabric or the holder being spherical.

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In regard to claim 20, the specification and figures do not disclose the holder 16 being solid or spherical.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 8-15, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 8, the term "the sleeve and hook" renders the claim vague and indefinite since in claim 1 the term "hook means" was previously set forth.

In regard to claim 8, the phrase "the sleeve and hook...they can swivel at opposite ends of a holder" renders the claim vague and indefinite since in the Figures 1-3 it appears that the lines 18 and item 24 are attached to the holder 16 on the same lower hemisphere but not at opposite ends.

In regard to claim 12, the term "the hook" renders the claim vague and indefinite since in claim 1 the term "hook means" was previously set forth. Also see claims 13-15 for the same problem.

In regard to claim 15, the term "the protruded hook" lacks positive antecedent basis. This claim should depend from claim 14.

In regard to claim 15, line 1, the phrase "the protruded hook and is hidden by a..." renders the claim vague and indefinite. Possibly the term "and" should be deleted.

In regard to claim 20, the term "the bottom surface" lacks positive antecedent basis.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2, 4, 8-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kilander 5,950,345.

Kilander discloses a sleeve (12, 42); a hook means (50); and means which can be attached to a fishing line and for attaching the sleeve to the hook means (40, 36, 38, 32, 26, 28).

In regard to claim 4, Kilander discloses a cylindrical sleeve (12 is annular in cross section but not limited to triangular as shown and circular [see col. 2, lines 61-62]).

In regard to claim 8, Kilander discloses a holder (36) with means for attaching to a line (40).

In regard to claims 9 and 10, Kilander discloses arms (28) being attached to a ring (12) attached to the front end of the sleeve (front ends of 42).

In regard to claim 15, Kilander discloses a plurality of ribbons (ends of 42).

13. Claims 1, 2, 4, 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Franklin et al. 4,253,263.

Franklin et al. discloses a sleeve (1); a hook means (11); and means which can be attached to a fishing line and for attaching the sleeve to the hook means (15).

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14. Claims 1, 2, 4, 8-13, 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 02/19815 to Ogawa.

Ogawa discloses a sleeve (2); a hook means (10) disposed inside the rear end of the sleeve (9); means which can be attached to a fishing line and for attaching the sleeve to the hook means comprising a holder (8) with a plurality of arms (7); and a ring (5).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilander 5,950,345.

Kilander discloses a sleeve (12, 42), a spherical shaped holder (36, crimp on 38 which have solid portions) with an upper extension (40) and a bottom extension (38) to which is attached at least one hook (50), and a plurality of arms (28) extending to engage a ring (12), but does not disclose the sleeve made of silk, rayon, or polyethylene film. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the sleeve out of silk, rayon, or polyethylene film, since it has been held to be within the general skill of a worker in the art to select a known

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material on the basis of its suitability for the intended use as a matter of obvious design choice, and because silk, rayon, and polyethylene film are flexible and flaccid enough to generate the desired undulating motion to attract fish. *In re Leshin*, 125 USPQ 416.

17. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. 4,253,263.

Franklin et al. discloses the sleeve made of synthetic rubbery material, but does not disclose the sleeve made of silk, rayon, or polyethylene film. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the sleeve out of silk, rayon, or polyethylene film, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because silk, rayon, and polyethylene film are flexible and flaccid enough to generate the desired undulating motion to attract fish. *In re Leshin*, 125 USPQ 416.

18. Claims 8-15, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/19815 to Ogawa in view of Kilander 5,950,345.

Alternatively Ogawa discloses holder (8) with means for attachment to a fishing line (17), but does not disclose the sleeve and hook means being attached so that they can swivel on a holder. Kilander discloses the sleeve (12, 42) and hook means (50) attached so that they can swivel from a holder (36, 38) with means for attachment to a fishing line (40). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the sleeve, hook, and holder of Ogawa such that the sleeve and hook are attached to the holder and are capable of swiveling motion in view

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of Kilander in order to prevent the sleeve, hook, and their respective attachment means from twisting and tangling and also to allow the assembly to move freely in a natural manner.

In regard to claim 14, Ogawa and Kilander disclose the hook which projects just beyond the rear end of the sleeve (50 of Kilander).

In regard to claim 20, Ogawa does not disclose the upper extension which can swivel with respect to the holder or the lower extension which can swivel with respect to the holder. Kilander discloses the upper extension (40) which can swivel with respect to the holder and the lower extension (38) which can swivel with respect to the holder (36). It would have been obvious to a person of ordinary skill in the art to modify the holder of Ogawa such that it has upper and lower extensions that can swivel relative to the holder in view of Kilander in order to allow the lure to move independently of the fishing line to make a natural presentation and also to prevent any twisting in the fishing line from causing the lure to spin unnaturally.

Also in regard to claim 20, Ogawa does not disclose a silk sleeve. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the sleeve out of silk, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because silk is flexible and flaccid enough to generate the desired undulating motion to attract fish. *In re Leshin*, 125 USPQ 416.

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19. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/19815 to Ogawa in view of Kilander 5,950,345 as applied to claim 11 above, and further in view of Acker 4,914,851 or Dworski 4,831,770.

Alternatively, Ogawa and Kilander do not disclose the hook protruding beyond the rear end of the sleeve and hidden by ribbons. Acker and Dworski disclose a sleeve (12 OR 14) and a hook (36 OR 56) protruding just beyond the rear end of the sleeve (24 OR 16) and being hidden by ribbons (46, 50 OR 27, 30). It would have been obvious to modify the sleeve of Ogawa and Kilander such that the hook protrudes rearwardly of the sleeve and is hidden by ribbons in view of Acker or Dworski in order to place the hook at a rear location that will snag a fish striking from behind and provide means for simulating a moving tail and which camouflages the hook so that the fish is less wary of the lure.

20. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/19815 to Ogawa.

Ogawa discloses a cloth-made lure body (2), but does not disclose the sleeve made of silk, rayon, or polyethylene film. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the sleeve out of silk, rayon, or polyethylene film, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because silk, rayon, and polyethylene film are flexible and flaccid enough to generate the desired undulating motion to attract fish. *In re Leshin*, 125 USPQ 416.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (703) 305-3733 or (571) 272-6885. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Darren W. Ark
Primary Examiner
Art Unit 3643

DWA